

REMARKS

Claims 1, 3-12 and 22-23 are rejected under 35 USC 103a as being unpatentable over Applicant Admitted Prior Art (“Description of the Prior Art”) [herein after AAPA] and further in view of Fujii, US Patent No: 5,898,695 [herein after Fujii].

5 Applicant notes that the Examiner has changed the rejection of independent claims 1 and 22 to be 35 USC 103(a) according to the teachings of the AAPA and Fujii. However, the structure of Fujii is only related to a processor and random access memory (RAM) and does not disclose anything to do with servos and host interconnections. The motivation for the combination of AAPA with Fujii in the rejection by the Examiner was stated by the Examiner 10 to be “in order to take advantage of lowering system costs with respect to data packet transmissions [see Fujii, Col. 2, Lines 61-67]”. However, the applicant respectfully disagrees with the Examiner that said motivation would result in a person skilled in the art combining the teachings of Fujii with the AAPA to result in the present invention without further inventive process.

15 In particular, col 2, lines 61-67 of Fujii state “The present inventors have found out problems of an increased number of system components and an increased cost to be caused by the provision of the packet transport buffers 5 and 6 independently from the system memory. Even if the packet transport buffers are implemented in the demultiplexer 3, the increased circuit scale and an increased cost thereof are inevitable.” This section of Fujii is in 20 reference to Figure 2 showing packet transport buffers 5 and 6 and the demultiplexer 3. However, there is no obvious reduction in parts as a result of the utilizing the cited signals such as DREQ and DACK of Fujii with the AAPA as described by the applicant.

25 Applicant notes that Figure 2 of Fujii and the associated quotation of col 2, lines 61-67 do not have any relation to the AAPA of the present invention. The Examiner appears to have simply found a reference (Fujii) that teaches some signals being similar (but not the same) as the present invention, and then chose an improper reason why a person skilled in the art would take these signals out of the context of Fujii and somehow be combined with the

AAPA to result in the present invention. The Examiner contends that all of this could be done without inventive process by the person skilled in the art, however, this is not fair to the applicant and does not follow proper 35 USC 103 rejections. In particular, there must be some kind of reason why the various features utilized by the Examiner from Fujii would be 5 obvious to combine with the AAPA to result in the present invention. For example, there must be a teaching, suggestion, or motivation (commonly referred to as the TSM test) in the actual references or known to a person of ordinary skill in the art to combine the references in the way required to thereby result in the present invention. In the present rejection of claim 1 and 22, the Examiner appears to have struggled finding a motivation and instead just quoted 10 the goal of Fujii's invention, which has nothing to do with the material of the AAPA and would therefore not be obvious or provide a suggestion to a person skilled in the art to combined these signals with the AAPA in the same way as the present invention.

The applicant also refers to MPEP section 706.02(j) stating that a 35 USC 103 rejection must include three basic criteria: "First, there must be some suggestion or motivation, either 15 in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the 20 prior art and not based on applicant's disclosure." (MPEP 706.02(j))

Concerning the three basic criteria, applicant firstly asserts that the rejection of claims 1 and 22 is not proper because there is no suggestion or motivation to modify the reference or to combine the teachings. As previously stated, the AAPA has nothing to do with the design 25 of Fujii. Fujii does not include host and or servo units. A person skilled in the art would not be motivated to take random signals from Fujii to apply to the AAPA without some reason. Secondly, applicant asserts that there is no reasonable expectation of success because the AAPA and Fujii do not have anything to do with one another.

In summary, the applicant asserts that Fujii and the AAPA are in different areas of

technology and do not share common components. The fact that Fujii's internal design has some signals that behave in a similar way to some signals as the present invention should not be grounds to reject the present invention as being obvious. These signals are utilized in the context of Fujii's design and it is not obvious how to integrate them into the AAPA without 5 the advantage of reading the present invention's disclosure. Furthermore, because Fujii's design and the applicant's AAPA are not similar in any way, there would be no reasonable expectation of success to combine some signals disclosed by Fujii with the AAPA.

For at least these reasons, applicant asserts that the present invention as claimed in claims 1 and 22 should not be found unpatentable with respect to the teachings of the AAPA 10 in view of Fujii. Reconsideration of claims 1 and 22 is respectfully requested. Claims 2-21 and 23-28 are dependent upon claims 1 and 22, respectively and should therefore be allowable for at least the same reasons. Further comments regarding the patentability of the dependent claims is provided in the below sections.

15 **Claims 2, 13-21 and 24-28 are rejected under 35 USC 103a as being unpatentable over AAPA and Fujii and further in view of Satoh et al, US Pub No: 2003/0128702 [herein after Satoh].**

As previously mentioned, claims 2, 13-21 and 24-28 are dependent upon claims 1 and 22, respectively. Said dependent claims should therefore be found allowable for at least the 20 above-stated reasons as provided for independent claims 1 and 22.

Additionally, applicant would also like to point out that the motivation to "provide a variable time-division multiplex communication method and apparatus in the system" as was stated by the Examiner in the Office action of 07/26/2007 also does not have anything to do with the AAPA and Fujii. For one thing, neither AAPA nor Fujii would benefit from 25 including a time-division multiplex communication method. Furthermore, the present invention as claimed in claims 2, 13-21 and 24-28 also does not include such a system and therefore this motivation is not proper. Similar to the rejections of claims 1 and 22, the Examiner appears to have chosen a motivation that simply would not have existed to a person

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skilled in the art at the time the invention was made.

In summary, taking various pieces of the designs of Fujii and Satoh in combination with the teachings of the AAPA to thereby result in the present invention would not be possible without further inventive process. For this reason, applicant asserts that claims 2, 13-21 and 5 24-28 should not be found rejected under 35 USC 103(a) as being unpatentable over the AAPA and Fujii and further in view of Satoh. Reconsideration of dependent claims 2, 13-21 and 24-28 is respectfully requested.

Conclusion:

10 Thus, all pending claims are submitted to be in condition for allowance with respect to the cited art for at least the reasons presented above. The Examiner is encouraged to telephone the undersigned if there are informalities that can be resolved in a phone conversation, or if the Examiner has any ideas or suggestions for further advancing the prosecution of this case.

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Sincerely yours,



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Winston Hsu, Patent Agent No. 41,526

20 P.O. BOX 506, Merrifield, VA 22116, U.S.A.

Voice Mail: 302-729-1562

Facsimile: 806-498-6673

e-mail : winstonhsu@naipo.com

25 Note: Please leave a message in my voice mail if you need to talk to me. (The time in D.C. is 12 hours behind the Taiwan time, i.e. 9 AM in D.C. = 9 PM in Taiwan.)